

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): FOK, Kenny K.	Group Art Unit: 2617
App. No.: 09/848,070	Examiner: DANIEL Jr., Willie J.
Filed: May 3, 2001	Conf. No.: 7836
Title: INSTANT MESSAGING TO A MOBILE DEVICE	

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APPEAL BRIEF**Real Party In Interest**

The real party in interest is Kyocera Wireless Corporation, San Diego, California.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claims 50-62 as they appear in the Appendix stand finally rejected and are appealed.

Status of Amendments

No amendment to the claims has been allowed or filed since the final rejection of July 24, 2007.

Summary of Claimed Subject Matter

The independent claims on appeal are claims 50 and 57.

Claim 50 is directed to a system in which a “proxy server” or any other type of server can maintain the presence information of a wireless communication device with an instant messaging service such that the wireless communication device appears “online” even when in fact there is NO “data connection” between the wireless communication device and the wireless network. (See, e.g., page 3, line 22 to page 4, line 7; page 8, lines 10-13; page 12, lines 7-10).

Claim 57 is directed to a method in which a wireless communication device can log into an instant message service through a wireless network and more specifically through a proxy server within the wireless data network, wherein the proxy server maintains a stand-in presence for the wireless communication device such that the wireless communication device does not need to maintain an active data connection with the wireless data network. (See Id.)

Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 50-56 are patentable under 35 U.S.C. 103(a) over Carey et al. (Carey) (United States Patent No. 6,714,793) in view of Gudjonsson et al. (Gudjonsson) (U.S. Patent 6,564,261).

2. Whether claims 57-62 are patentable under 35 U.S.C. 103(a) over Carey in view of Gudjonsson in further view of Polychronidis et al. (Polychronidis) (U.S. Patent Publication No. 2003/0018704).
3. Whether claims 50 and 57 are patentable under 35 U.S.C. 103(a) over Carey in view of Guadalia et al. (Guadalia) (U.S. Patent No. 7,043,538).
4. Whether claims 50 and 57 are patentable under 35 U.S.C. 103(a) over Carey in view of Chen et al. (Chen) (U.S. Patent No. 7,020,685) in further view of Polychronidis.

Arguments

1. Rejection of Claims 50-56 under 35 U.S.C. §103(a) over Carey in view of Gudjonsson.

a. Claims 50-55

As a preliminary matter, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this

case, the rejection must fail because Carey and Gudjonsson alone or in combination, fail to teach each and every element of the claims as amended.

Further, as the Federal Circuit has made clear, the first two criteria inform the prongs of the three-way test referred to in *Graham v. John Deere* in order to prevent the reliance on impermissible hindsight. In this case, the references fail to provide a proper motivation to combine the references or reasonable expectation of success. Accordingly, with respect to claims 50-55 the rejection must fail and is at best based on improper hindsight.

For example, independent claim 50 is directed to system in which a “proxy server” or any other type of server can maintain the presence information of the wireless communication device with an instant messaging service such that the wireless communications device appears “online” even when in fact there is NO “data connection” between the wireless communication device and the wireless network. Prior art systems, including those described in the art cited in the Action, simply do not make a wireless device appear online, without a data connection to the device.

Prior Actions acknowledge the Carey et al. reference does not teach this limitation (See non-Final Office Action of February 6, 2007); however, the Final Action states the Examiner’s opinion that this limitation was well known in the art and cites the teachings of Gudjonsson as evidence in support of his opinion.

Applicant respectfully asserts that this limitation was not well known, and a close examination of Gudjonsson reveals that it does not in fact support the Examiner’s opinion. Rather, Gudjonsson fails to cure the deficiencies of Carey. The sections (col. 7, line 53 – col. 8, line 30; col. 8, lines 53-65, col. 11 lines 32-64) of Gudjonsson et al.

offered by the Final Action of July 24, 2007 merely teach connection servers (col. 8, lines 19-21) that provide services such as: storing “presence data” associated with a user on a database (col. 8, lines 54-56), publishing dynamic user status information **to indicate** “whether the user is currently online on his/her PC or not” (col. 8, lines 57-60), and providing users with the ability **to check** whether other users are connected to the same connection servers are online (col. 8, lines 61-63).

In fact, a close look at each of the cited passages reveals the repeated emphasis within Gudjonsson on the need for the devices to be connected in order to establish, maintain, and monitor presence information. For example, column 2, lines 20-22, states “status is usually defined as whether a user is **currently connected to the network** or not.” Column 7, line 53 to column 8 line 30, and more specifically col. 8, lines 18-23, states “[e]xternal users 7 and their respective client devices 11 . . . can **connect** to services within the cluster via a special connection service, that typically runs on serve(s) (connection servers) at the boundary of the cluster’s firewall 9, and listens for **connections** on a specific port.” Column 8, lines 53-56, and more particularly lines 53-56, state that the user (not a proxy for the user) has “the ability to define arbitrary sets of data related to that identity . . . and this data is referred to herein as “presence” data of the user.” Column 11, lines 32-64, and more particularly lines 38-39, states “the client 11 **connects** to the corresponding server 3 and establishes a secure **connection** with it.”

No where, and certainly not in the text cited in the Final action, does Gudjonsson disclose maintaining presence for a user even when that user is not connected.

Gudjonsson discloses at column 3, lines 14-17 that “the routing service allows users to

send invitations to other users to establish an arbitrary communication session . . . over arbitrary networks.” But even here it does not say that the routing service or a server will maintain presence on behalf of a user even when that user is not connected.

Accordingly, Carey and Gudjonsson, alone or in combination, do not teach all of the limitations of claim 50, nor does Gudjonsson provide any motive to modify the teachings of Carey to achieve the invention as claimed in claim 50. Claims 51-55 depend from claim 50 and are allowable for the at least the same reasons as claim 50. Applicant therefore respectfully request withdrawal of the rejection of claims 50-55.

b. Claim 56

Claim 56 depends on claim 50 and adds “wherein the proxy server receives an indication that the wireless communications device is in an inactive state, and wherein the proxy server removes the substitute proxy server presence upon receipt of the indication that the wireless communications device in the inactive state.” The Final Action alleges that Carey teaches this limitation; however, if Carey does not teach the substitute proxy presence of claim 50, as admitted in the Final Action, then it cannot teach this additional limitation of claim 56. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 56.

2. Rejection of Claims 57-62 under 35 U.S.C. §103(a) over Carey in view of Gudjonsson in further view of Polychronidis.

a. Claims 57-62

The Final Action rejects claim 57 on similar grounds as claim 50 and combines Carey and Gudjonsson in a similar manner as with respect to claim 50. Claim 57 is

directed to similar subject matter as claim 50. Accordingly, claim 57 is allowable over the combination of Carey and Gudjonsson for similar reasons as claim 50.

Polychronidis also fails to cure the deficiencies of Carey in light of Gudjonsson and the Final Action does not allege anything to the contrary. Polychronidis merely teaches a push or pull agent that accepts queries for presence/location information from an application. (See pg. 3, paragraph 34-35, 37.) The pull agent then queries the Home Location Register (HLR) of the wireless network for the requested information, and relays this information to the application. (Id.)

Accordingly, Carey, Gudjonsson and Polychronidis, alone or in combination, do not teach all of the limitations of claim 57, nor does Gudjonsson or Polychronidis provide any motive to modify the teachings of Carey to achieve the invention as claimed in claim 57. Claims 58-62 depend from claim 57 and are allowable for the at least the same reasons as claim 57. Applicant therefore respectfully request withdrawal of the rejection of claims 57-62.

3. Rejection of Claims 50 and 57 under 35 U.S.C. §103(a) over Carey in view of Guedalia.

a. Claim 50 and 57

In this rejection, the Final Action attempts to plug Guedalia into the hole that Gudjonsson could not fill with respect to the teachings of Carey. But Guedalia also fails to cure the deficiencies of Carey. Guedalia merely teaches a presence server that “maintains an active session” with an external server (i.e., instant messaging service) even when a user is disconnected from the presence server (col. 5, lines 4-10). There is no teaching or suggestion in Guedalia that the presence server “actively” transmits

presence information to the external server (i.e., instant messaging service) to fool it into thinking that the user (i.e. wireless communications device) is online even when he/she is disconnected from the presence server. The fact that an “active session” is maintained by the presence server cannot be inferred to mean that the presence server is actively transmitting presence information to the external server. They are mutually exclusive concepts.

Accordingly, Carey and Guadalía, alone or in combination, do not teach all of the limitations of claims 50 and 57, nor does Guadalía provide any motive to modify the teachings of Carey to achieve the invention as claimed in claims 50 and 57. Applicant therefore respectfully request withdrawal of the rejection of claims 50 and 57.

3. Rejection of Claims 50 and 57 under 35 U.S.C. §103(a) over Carey in view of Chen in further view of Polychronidis.

a. Claim 50 and 57

In this rejection, the Final Action attempts to plug Chen into the hole that Gudjonsson and Guadalía could not fill with respect to the teachings of Carey. But Chen too also fails to cure the deficiencies of Carey. The section of Chen cited in the Action (col. 1, lines 63-65 and FIGs 1 and 4) merely teaches that a proxy server, between a wireless device and one or more network servers, can facilitate the transmission of SMS messages. Chen is completely silent as to the proxy server having any capability of actively transmitting presence information to the one or more of the network servers to indicate that the wireless device is online even when the wireless device is disconnected from the proxy server.

Accordingly, Carey, Chen and Polychronidis, alone or in combination, do not teach all of the limitations of claims 50 and 57, nor does Chen or Polychronidis provide any motive to modify the teachings of Carey to achieve the invention as claimed in claims 50 and 57. Applicant therefore respectfully request withdrawal of the rejection of claims 50 and 57.

Please charge any other fees necessitated by this response to Deposit Account Number 50-3001 referencing attorney docket number UTL 00015.

Respectfully Submitted,

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CLAIMS APPENDIX
(Claims Involved in the Appeal)

In the Claims:

50. A system for providing a wireless communications device access to an instant messaging service on a data network, the instant messaging service communicating instant messages in an instant message format, the system comprising:

a wireless network;

a short message service (SMS) center connected to the wireless network;

a proxy server having a first connection to the SMS center and a second connection to the data network, the proxy server for establishing a substitute proxy presence on the data network for the wireless communications device, the proxy server for transmitting presence information to the instant messaging service to indicate that the wireless communications device is online even when a data connection does not exist between the wireless communication device and the wireless network, the proxy server for intercepting and storing an instant message addressed to the wireless communications device; and

a plurality of information handling systems connected to the data network and logged into the instant messaging service for sending and receiving the instant messages.

51. The system of claim 50, wherein the proxy server notifies the SMS center that the instant message addressed to the wireless communications device has been received.

52. The system of claim 50, wherein the proxy server converts at least a portion of the intercepted instant message to a short message format, and sends a converted message to the wireless communications device through the wireless network via the SMS center.

53. The system of claim 50, wherein the proxy server converts an identifier of a sender of the intercepted instant message to a short message format and sends the converted identifier of the sender to the wireless communications device.

54. The system of claim 52, wherein the SMS center stores the converted message.

55. The system of claim 50, wherein the proxy server receives a response short message from the wireless communication device that is addressed to an information handling system of the plurality of information handling systems, converts the response short message to an instant message format response message, and sends the instant message response message to the information handling system.

56. The system of claim 50, wherein the proxy server receives an indication that the wireless communications device is in an inactive state, and wherein the proxy server removes the substitute proxy server presence upon receipt of the indication that the wireless communications device is in the inactive state.

57. A method for providing a wireless communications device access to an instant messaging service connected to a data network, the method comprising the steps of:

communicating an active message state status from the wireless communications device to a wireless network, wherein the wireless network is connected to a short messaging service (SMS) center, the SMS center is connected to a proxy server, and the proxy server is connected to the data network;

the proxy server establishing a stand-in on-line presence for the wireless communications device with the instant messaging service even when a data connection does not exist between the wireless communication device and the wireless network;

the proxy server maintaining the stand-in on-line presence as long as the wireless communications device remains in the active message state status,

the proxy server determining that the wireless communications device is in the active message state status if the wireless communications device is responsive to a special SMS message

that is periodically sent by the proxy server to the wireless communications device; and

the proxy server intercepting and storing at least one instant message intended for the wireless communications device.

58. The method of claim 57 further comprising the steps of:
the proxy server converting at least a portion of the at least one instant message to short message service (SMS) format;
sending the converted message to the SMS center;
the SMS center sending the converted message to the wireless network; and the wireless network delivering the converted message to the wireless communications device.

59. The method of claim 57, further comprising the step of:
the proxy server notifying the wireless communications device through the SMS center and the wireless network that the at least one instant message has been received.

60. The method of claim 59, wherein the step of notifying comprises the steps of:
the proxy server converting at least a portion of the at least one instant message from instant message format to short message service (SMS) format; and
sending the converted message to the wireless communications device through the SMS center.

61. The method of claim 60, further comprising the step of:
the proxy server converting an identifier of the sender of the at least one instant message from the instant message format to SMS format; and
sending the converted identifier to the wireless communications device.

62. The method of claim 58, further comprising the steps of:
the wireless communication device sending a response message transmitted in short message service format to the proxy server; and
the proxy server converting the response message to instant message format and transmitting the converted response message over the data network.

EVIDENCE APPENDIX

(NONE)

RELATED PROCEEDINGS APPENDIX

(NONE)